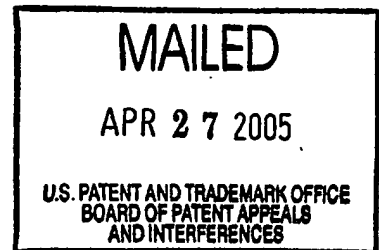Paper No. 26

# UNITED STATES PATENT AND TRADEMARK OFFICE

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

*Ex parte* JURGEN BRIESKORN, MARKKU KORPI,
MICHAEL SASSIN, and SHMUEL SHAFFER

Appeal No. 2005-0034
Application No. 09/281,695

**MAILED**

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

HEARD: April 19, 2005

Before HAIRSTON, GROSS, and BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

## DECISION ON APPEAL

A patent examiner rejected claims 1-20. The appellants appeal therefrom under

35 U.S.C. § 134(a). We reverse.

# BACKGROUND[1]

The invention at issue on appeal concerns communications terminals.

A communications terminal can be characterized by the features it makes available,

e.g., establishing and clearing connections to other communications terminals,

redirecting incoming calls. Such features can be defined by "program sections" stored

in a memory chip. (Spec. at 1.)

Features may be added to a communications terminal by replacing the memory

chip, which the appellants complain is time-consuming and requires "specialist

expertise." (*Id.* at 1-2.) Alternatively, the terminal may be replaced with a new device,

which entails acquisition costs. Because a user's personal data stored in the memory

of the communications terminal are not usually transferred into the memory of the new

device, they add, the data are lost. (*Id.* at 2.)

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[1]An appeal "brief shall contain . . . "[a] concise explanation of the invention
defined in the claims involved in the appeal, which shall refer to the specification by
page and line number, and to the drawing, if any, by reference characters." 37 C.F.R.
§ 1.192(c)(5)(2003). Here, the *Summary of the Invention* section of the appellants' brief
is not a concise explanation of the invention defined in the claims involved in the
appeal. It merely reproduces the *Description of the Preferred Embodiments* of their
specification.

In contrast, the appellants' invention "influence[s] the function of a

communications terminal without having to make changes [there]to. . . ." (*Id.* at 3.)

More specifically, their communications terminal transmits status data (e.g., a key input

from a user) to a remote computer. Based on the status data, the remote computer

returns an instruction sequence to the terminal. A controller therein employs the

sequence as a program section which, when processed, provides a feature. (*Id.*)

A further understanding of the invention can be achieved by reading the following claim.

    1. A communications system, comprising:

        a first communications terminal to be connected, via a first network,
to a second communications terminal;

        a remote computer;

        said first communications terminal having a central controller
transmitting status data relating to functional features of said first
communications terminal to said remote computer via a second network,
said remote computer being programmed to automatically evaluate the
status data and to generate an instruction sequence from the status data
and to transmit the instruction sequence to said first communications
terminal via the second network; and

        said central controller employing the instruction sequence as a
program section and providing the functional features to said first
communications terminal upon processing the program section.

Claims 1 and 13-20 stand rejected under 35 U.S.C. § 102(b) as anticipated by

U.S. Patent No. 5,533,102. ("Robinson"). Claims 2-4 stand rejected under 35 U.S.C.

§ 103(a) as obvious over Robinson, with U.S. Patent Application Pub. No. US 2001/

0043608 ("Potter") and U.S. Patent No. 6,163,532 ("Taguchi"), cited as evidence of

well-known art. Claims 5-9 stand rejected under § 103(a) as obvious over Robinson,

with Potter and U.S. Patent No. 6,449,260 ("Sassin"), cited as evidence of well-known

art. Claims 10-12 stand rejected under § 103(a) as obvious over Robinson and U.S.

Patent No. 6,052,461 ("Lam").


OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we

focus on a point of contention therebetween. The examiner asserts, "Robinson

teaches . . . transmitting status data relating to functional features of said first

communications terminal to said remote computer via a second network ((the called

party API allows the called party to send commands to the auto-attendant system 200

or the call processor system 38 to affect the flow of caller conversation, such as **a

change state command** (col. 6, lines 25-34). . . ." (Examiner's Answer at 3-4

(emphasis added).) The appellants argue, "mere state change requests do not

represent current states of a system in contrast to status data which actually serve to

monitor or observe a system's internal state." (Appeal Br. at 14.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the claim at issue to determine its scope. Second, we determine whether the construed claim is anticipated or would have been obvious.

## 1. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — what is the invention claimed?" Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). "The general rule is, of course, that terms in the claim are to be given their ordinary and accustomed meaning." Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999) (citing Renishaw PLC v. Marposs Societa Per Azioni, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998); York Prods., Inc. v. Central Tractor Farm & Family Ctr., 99 F.3d 1568, 1572, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996)). "It is well settled that dictionaries provide evidence of a claim term's 'ordinary meaning.'" Inverness Med. Switz. GmbH v. Warner Lambert Co., 309 F.3d 1365, 1369, 64 USPQ2d 1926, 1930 (Fed. Cir. 2002) (citing Texas Digital Sys. Inc. v. Telegenix Inc., 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002); CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002)).

Here, claim 1 recites in pertinent part the following limitations: "said first

communications terminal having a central controller transmitting status data relating to

functional features of said first communications terminal to said remote computer via a

second network. . . ." The ordinary meaning of the term "status" is "[t]he condition at a

particular time of any of numerous elements of computing — a device,

a communications channel, a network station, a program, a bit, a byte, and so on."

*Microsoft Press Computer Dictionary* 373 (2d ed. 1994). Giving the term its ordinary

meaning, the limitations require transmitting data that report the condition of a

communications terminal at a particular time.

## 2. ANTICIPATION AND OBVIOUSNESS DETERMINATIONS

"Having construed the claim limitations at issue, we now compare the claims to

the prior art to determine if the prior art anticipates those claims." *In re Cruciferous*

*Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "A claim

is anticipated only if each and every element as set forth in the claim is found, either

expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc.*

*v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing

*Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264,

1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220

USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771,

218 USPQ 781, 789 (Fed. Cir. 1983)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Here, Robinson "relates to . . . a method and apparatus for providing a telephone user with information concerning a caller, and means for instructing an auto attendant how to handle the call." Col. 1, ll. 14-18. The reference's "FIG. 2 is a schematic diagram of the operation of a conventional auto-attendant system 200 together with the operation of an additional system 202 for coordinating the called party commands with the on-going conversation." Col. 5, ll. 42-45. A "communications link [from the caller] to the called party is accomplished via Remote Procedure Calls (RPC) 210 over a Local Area Network (LAN) to an application program running on the called party's personal computer (PC) 212." *Id.* at ll. 59-62. An "application on the PC 212 can then interact with the auto-attendant system 200 via an Application Programming Interface (API). . . .

The called party API includes the functions described below which meet three requirements. . . ." *Id.* at ll. 63-67. The examiner relies on the third such requirement, *supra.* Although this requirement may involve transmitting data, we are unpersuaded that the data report the condition of a communications terminal at a particular time. To the contrary, the data are used to control the reference's auto-attendant system. More

specifically, the data "allow the called party to send commands to the auto-attendant system 200 to affect the flow of the caller conversation, such as a change state command." *Id.* at ll. 25-27. "Commands from the called party application to the auto attendant system include a pointer to a call handle, a value indicating the state the called party wishes to move the call to, and a pointer to a block of parameters with additional information about the state to be moved to, such as an indication of which of several greetings the called party would like to have played to the caller." *Id.* at ll. 27-34.

The absence of transmitting data that report the condition of a communications terminal at a particular time negates anticipation. Therefore, we reverse the anticipation rejection of claim 1 and of claims 13-20, which depend therefrom.

The examiner does not allege, let alone show, that the addition of Potter, Taguchi, Sassin, or Lam cures the aforementioned deficiency of Robinson. Absent a teaching or suggestion of transmitting data that report the condition of a communications terminal at a particular time, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejections of claims 2-12.

## CONCLUSION

In summary, the rejection of claims 1 and 13-20 under § 102(b) is reversed. The rejection of claims 2-12 under § 103(a) is also reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

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ANITA PELLMAN GROSS                 ) BOARD OF PATENT
Administrative Patent Judge         )    APPEALS
                                    )    AND
                                    ) INTERFERENCES
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                                    )
LANCE LEONARD BARRY                 )
Administrative Patent Judge         )

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